

REQUEST FOR RECONSIDERATION
August 25, 2006

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Serial No. 10/065,745

REMARKS

Claims 1 – 11 remain in the application and stand rejected. The rejection is respectfully traversed.

Claims 10 and 11 are rejected under 35 USC §112 as failing to comply with the written description requirement. The MPEP at §2163.07(a) provides in pertinent part that:

By disclosing in a patent application a device that inherently performs a function or has a property, operates according to a theory or has an advantage, a patent application necessarily discloses that function, theory or advantage, even though it says nothing explicit concerning it. The application may later be amended to recite the function, theory or advantage without introducing prohibited new matter. *In re Reynolds*, 443 F.2d 384, 170 USPQ 94 (CCPA 1971); *In re Smythe*, 480 F. 2d 1376, 178 USPQ 279 (CCPA 1973).

As previously noted in the Amendment After Final, filed April 10, 2006, according the present application, “each controller can be configured, by adding RIP machines and connecting networks, to suit the needs of each customer.” Paragraph 0010 of the published application, which corresponds to page 3, lines 14 – 15 of the application as filed. Furthermore, as represented in Figure 2, the sequencer 21 is networked with and directly connected to a separate and variable number (*n*) of RIP machines 22*a*, 22*b*, 22*c*, ... 22*n*. See, page 7, lines 12 – 13, which corresponds to paragraph 0026 of the published application. Clearly, both explicitly and implicitly, this supports “wherein said raster image processors [RIP machines 22*a*, 22*b*, 22*c*, ... 22*n*] may be connected and disconnected to said sequencer [21] output port, said sequencer remaining unchanged by additions and removals of connected and disconnected said raster image processors,” as claims 10 and 11 recite. As with a typical LAN, for example, by networking the RIP machines 22*a*, 22*b*, 22*c*, ... 22*n* with the sequencer 21, RIP machines 22*a*, 22*b*, 22*c*, ...

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22n may be added and removed from the network without disturbing the sequencer 21 and transparently to the controller (11 in Fig. 1). Accordingly, the applicants believe to have clearly shown that "the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill." MPEP §2163.07(a).

Further, this recitation of claims 10 and 11 is not possible with the references of record. Barry et al., for example, shows a dedicated connection between the distributor 116 (connected to the alleged sequencer, upstream instruction operator 114) and portion selectors 140, 144, 148 connected to the down stream RIP engines 150, 152, 154. Adding another RIP engine to Barry et al., for example, requires another line/path. Therefore, this is not shown or suggested by Barry et al., nor as far as the applicants can tell, does any reference of record to teach or suggest this, alone or further in combination with any other reference of record. Accordingly, believing to have shown the recitations of claims 10 and 11 to be supported by the present application as filed and specifically by Figure 2 and any appurtenant description thereof, reconsideration and withdrawal of the rejection of claims 10 and 11 under 35 U.S.C. §112 is respectfully requested.

Claims 1 and 3 are rejected under 35 USC §103(a) as being unpatentable over U.S. Patent No. 6,825,943 to Barry et al. in view of U.S. Patent No. 6,315,390 to Fujii. Claims 2 and 6 – 11 are rejected under 35 USC §103(a) as being unpatentable over Barry et al. and Fujii in further view of U.S. Patent No. 6,532,016 to Venkateswar et al. Claims 4 and 5 are rejected under 35 USC §103(a) as being unpatentable over Barry et al. and Fujii in further view of U.S. Patent No. 5,946,460 to Hohensee et al.

Essentially otherwise repeating the previous rejections of claims 1 and 3, it is acknowledged that "Barry et al. do not disclose expressly a sequencer directly connected to the input ports of the raster image processors." Regardless, however, without providing any substantive basis, the Office action asserts that "it would have been obvious to a

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person of ordinary skill in the art to directly connect the sequencer with the input ports of the raster image processors.” Then, ignoring both the advantages recited in claims 10 and 11, and the requirements for establishing obviousness as a whole under 35 USC §103(a), the Office action *sua sponte* shifts the burden of proof asserting that “Applicant has not disclosed that directly connecting the sequencer with the input ports of the raster image processors provides an advantage, is used for a particular purpose or solves a stated problem.” What is the statutory basis for this requirement? The applicants are aware of none and no legal authority has been cited. While the invention must be new and useful to comply with the requirements of 35 USC §101 and 102, this requirement does not apply to each and every element of a claim, much less specific recitations within the elements. Apparently considering the burden shifted, the Office action concludes that “One of ordinary skill in the art, therefore, would have expected **Applicant’s invention** to perform equally well with a distributor connecting the sequencer and the raster image processor because both designs perform the same function of parsing and distributing the images to the raster image processors.” (emphasis added.) What does how the applicants invention would be expected to perform have to do with what the references show?

“In determining the differences between the prior art and the claims, the question under 35 U.S.C. 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious.” MPEP §2141.02(I), (citations omitted, emphasis original). “Distilling an invention down to the ‘gist’ or ‘thrust’ of an invention disregards the requirement of analyzing the subject matter ‘as a whole.’” *Id.*, §2141.02(II), (citations omitted). Yet that is very clearly what is being done here. Claim 1 recites “a sequencer which has an output port networked and communicating with, and directly connected to, the input ports of said plurality of raster image processors” at lines 9 – 11, not “a sequencer directly connected to the input ports of the raster image processors.” Therefore, patentability of claim 1 clearly is not being considered as a whole, but instead being distilled “down to the ‘gist’ or ‘thrust’” and so,

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prima facie obviousness has not been established for claim 1 or any claim depending therefrom.

Furthermore, in finding obviousness “impermissible hindsight must be avoided and the legal conclusion must be reached on the basis of the facts gleaned from the prior art.” *MPEP* §2142 (emphasis added). Thus, obviousness is based on a legal standard, not what one may feel with respect to the particular invention. “To support the conclusion that the claimed invention is directed to obvious subject matter, either the references must expressly or impliedly suggest the claimed invention or the examiner must present a convincing line of reasoning as to why the artisan would have found the claimed invention to have been obvious in light of the teachings of the references.” *Ex parte Clapp*, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985) (emphasis added). An obviousness rejection cannot be based on the resort to the combination of bits and pieces of the references in the light of applicants’ teachings. An extensive discussion of the criteria to be applied in obviousness rulings is set forth in *Aqua-Aerobic Systems Inc. v. Richards of Rockford Inc.*, 1 U.S.P.Q. 2d 1945, 1955-57 (N.D. Ill. 1986). “The fact that a prior art reference can be modified to show the patented invention does not make the modification obvious unless the prior art reference suggests the desirability of the modification. An attempted modification of a prior art reference that is unwarranted by the disclosure of that reference is improper.” *In re Gordon*, 733 F.2d 900, 902, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984) (emphasis added). *See also, In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990) (Although a prior art device “may be capable of being modified to run the way the apparatus is claimed, there must be a suggestion or motivation in the reference to do so.” 916 F.2d at 682, 16 USPQ2d at 1432 (emphasis added)).

Clearly, the burden is on the Office to show a suggestion, not on the applicant to show that a particular recited difference “provides an advantage, is used for a particular purpose or solves a stated problem.” However, nothing was shown in any of the

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references that expressly or impliedly suggest the claimed invention as recited in claim 1. Instead, very clearly resorting to improper hindsight, the Office action asserts that "One of ordinary skill in the art, therefore, would have expected **Applicant's invention** to perform..." The present application is being used in improper hindsight to suggest claim 1 and to suggest modifying the references to result in claim 1. Therefore, *prima facie* obviousness has not been established for claim 1 or any claim depending therefrom.

Because "a sequencer which has an output port networked and communicating with, and directly connected to, the input ports of said plurality of raster image processors" as recited by claim 1, is not taught or suggested by any reference of record; because claim 1 clearly is being distilled "down to the 'gist' or 'thrust'" instead of examining what claim 1 recites as a whole; and because the present application is being used in improper hindsight to suggest claim 1 and to suggest modifying the references to result in claim 1, *prima facie* obviousness has not been established for claim 1 or any of claims 2 – 4 and 10, which depend therefrom. Reconsideration and withdrawal of the rejection of claims 1 – 4 under 35 U.S.C. §103(a) is respectfully requested.

Regarding claim 5, essentially repeating the previous rejections, it is essentially asserted that Barry et al. discloses the invention with Fujii et al. being relied upon solely to "disclose a plurality of print head drivers," and Hohensee et al. being cited to "disclose each of said raster image processors converts data from a form communicated as a print data stream into a variable number of portions depending upon whether an individual page is to be blank or to be printed with a single color or to be printed with multiple colors (col. 4, lines 53-60)." However, this ignores the amendment to claim 5, which was included in, and appeared in part to be the basis in the Advisory Office action for refusing entry of, the Amendment After Final. Specifically, claim 5 recites that the "pipeline of elements [are] **connected between** a print server and a printer and processing print control data from said print server," which is neither taught nor suggested by any reference of record. Although the Office action alleges on page 7 that

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Referring to claim 5, Barry et al. disclose an apparatus comprising: a pipeline of elements connected between a printer server and a printer and processing print control data from said print server, and said pipeline of elements having: a plurality of raster image processors, each of which has an input port receiving parsed page data (Rip engines 150, 152, and 154 of Fig. 1b, col. 1, lines 41-50);

there is no substantive support for this allegation. Nowhere does Barry et al. show or suggest "a pipeline of elements connected between a print server and a printer and processing print control data from said print server," and wherein the pipeline elements are as claim 5 recites. Nothing has been provided in any Office action to indicate where in the cited references "a pipeline of elements connected between a print server and a printer and processing print control data from said print server," as claim 5 recites might be found. Nor could there be!

In particular, Fujii et al., which again is cited to teach multiple print head drivers, teaches an ink jet head in an ink jet printer 150. See, e.g., Figures 11 - 13. Thus, while Fujii et al. may teach multiple print head drivers, they are all located in the Fujii et al. printer 150. Well, if they are located in the printer 150, they cannot be "between a print server and [the] printer" as claim 5 recites. Neither is this shortcoming of the combination of Barry et al. with the Fujii et al. cured by the addition of Hohensee et al. Therefore the combination of Barry et al. with Fujii et al. and Hohensee et al. or further in combination with any reference of record, does not result in the present invention as recited in claim 5 or in claim 11, which depends therefrom. Accordingly, since the combination of Barry et al. with Fujii et al. and Hohensee et al. does not result in the present invention as recited in claims 5, claim 5 is not made obvious under 35 U.S.C. §103(a) by Barry et al. with Fujii et al. and Hohensee et al. or further in combination with any reference of record. Reconsideration and withdrawal of the rejection of claim 5 under 35 U.S.C. §103(a) is respectfully requested.

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Regarding the rejection of claims 6 – 9, the Office action also ignores the recitations in claims 6 and 9 included in the Amendment After Final. Specifically, it is asserted that the recitation of claim 6, line 2 and claim 9, line 5 of “receiving a print data stream **from a print server** and parsing the stream into local (col. 4, lines 34-38) and global portions (col. 4, lines 26-30)” (emphasis added); which fails to show anything with respect to the origination of the data. Similarly, it is asserted that the recitation of claim 6, lines 10 – 11 and claim 9, lines 13 – 14, that “the generated print head driving data signals [are communicated] to **a printer** and to the print heads of said printer” (emphasis added) is shown at col. 6, lines 60 – 65. These recitations of claims 6 and 9, which locate the method between the print server and the printer, were also included in, and also appeared in part to be, the basis in the Advisory Office action for refusing entry of, the Amendment After Final.

Notably, the Office action asserts that “Venkateswar et al. disclose ... communicating queued packaged print stream data portions directly to a plurality of raster image processors (col. 2, lines 21-28).” However, claim 6 clearly recites “communicating queued packaged print stream data portions directly **over a network** to a plurality of raster image processors” at lines 5 – 6. Communicating over a network entails more than communicating directly over a dedicated path as disclosed in Barry et al. As previously noted, this recitation of claim 6 is quite different than an instruction operator 114 passing a data stream to a distributor 118 that “provides the print job file 104 including a first select portion 140 along a line 142 to a first RIP engine 150.” Barry et al. col. 5, lines 14 – 16. Therefore, because while it might be alleged that “Venkateswar et al. disclose ... communicating queued packaged print stream data portions directly to a plurality of raster image processors” it has not been alleged that any reference of record teaches “communicating queued packaged print stream data portions directly **over a network** to a plurality of raster image processors” as claim 6 recites. Accordingly, *prima facie* obviousness has not been established for claim 6 or any claim depending therefrom. Nor is this taught or suggested by any of Barry et al., Fujii et al.,

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Venkateswar et al., or any other reference of record. Therefore, the combination of Barry et al., Fujii et al. and Venkateswar et al. or, further in combination with any other reference of record does not result in the present invention as recited in claim 6 or 9 or, in claim 7 or 8 which depend from claim 6. Reconsideration and withdrawal of the rejection of claims 6 – 9 under 35 U.S.C. §103(a) is respectfully requested.

Regarding the rejection of claims 10 and 11, neither do any of Barry et al., Fujii et al., Hohensee et al. or Venkateswar et al. teach or suggest facilely adding or removing raster image processors at the sequencer output port as recited in claims 10 and 11. Thus, neither does the combination of Barry et al. with Fujii et al., alone or further in combination with any reference of record, suggest or result in the present invention as recited in claims 10 and 11. Neither has the Office action asserted that this recited difference is taught in any reference of record. Instead, this difference is also ignored in rejecting claims 10 and 11 and so, *prima facie* obviousness has not been established for either of claim 10 or 11. Accordingly, reconsideration and withdrawal of the rejection of claims 10 and 11 under 35 U.S.C. §103(a) over is respectfully requested.

The applicants thank the Examiner for efforts, both past and present, in examining the application. Believing the application to be in condition for allowance for the reasons set forth above, the applicants respectfully request that the Examiner reconsider and withdraw the rejection of claims 1 – 11 under 35 U.S.C. §§103(a) and 112, and allow the application to issue.

As previously noted the MPEP §706 “Rejection of Claims,” subsection III, “PATENTABLE SUBJECT MATTER DISCLOSED BUT NOT CLAIMED” provides in pertinent part that

If the examiner is satisfied after the search has been completed that patentable subject matter has been disclosed and the record indicates that the applicant intends to claim such subject matter, he or she may note in the Office action that certain aspects or features of the patentable

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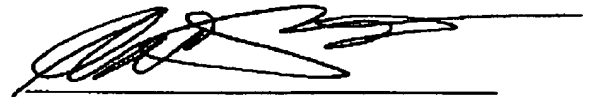
invention have not been claimed and that if properly claimed such claims
may be given favorable consideration. (emphasis added.)
The applicants believe that the written description of the present application is quite
different than, and not suggested by, any reference of record. Accordingly, should the
Examiner believe anything further may be required, the Examiner is requested to contact
the undersigned attorney at the local telephone number listed below for a telephonic or
personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM
Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

August 25, 2006
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invention have not been claimed and that if properly claimed such claims **may be given favorable consideration.** (emphasis added.)
The applicants believe that the written description of the present application is quite different than, and not suggested by, any reference of record. Accordingly, should the Examiner believe anything further may be required, the Examiner is requested to contact the undersigned attorney at the local telephone number listed below for a telephonic or personal interview to discuss any other changes.

Please charge any deficiencies in fees and credit any overpayment of fees to IBM Corporation Deposit Account No. 50-3669 and advise us accordingly.

Respectfully Submitted,

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